

Statement of Considerations

ADVANCE WAIVER OF THE U.S. GOVERNMENT'S DOMESTIC AND FOREIGN PATENT RIGHTS IN SUBJECT INVENTIONS ARISING UNDER THE DEPARTMENT'S ACCELERATED SITE TECHNOLOGY DEPLOYMENT TO THE AWARDEES AND ANY LARGE BUSINESS LOWER TIER SUBCONTRACTORS THEREUNDER W(C)-98-003 CH-0952


This is a waiver of the U.S. Government's domestic and foreign patent rights in subject inventions made under awards issued in the Department of Energy's Accelerated Site Technology Deployment. The class waiver applies to the prime awardees and also to any lower tier subcontractors provided the other criteria for the class waiver are met. This class waiver does not apply to domestic small business and nonprofit organizations which are entitled to elect to retain title to their subject inventions pursuant to Public Law 96-517, as amended. This class waiver is based upon and continues the policy and philosophy of the Department of Energy in issuing a waiver to those contractors engaged in the Department of Energy's Environmental Remediation Demonstrations at Designated Test Bed Facilities, as set out in the Statement of Considerations for the "Advance Waiver of the U.S. Government's Domestic and Foreign Rights in Subject Inventions Arising under Innovative Technology Demonstration Projects at Technology Development-Designated Test Bed Facilities to the Demonstrator and to the Large Business Lower Tier Subcontractors Thereunder", W(C)-95-014 (initially issued as W(A)-95-011).

This advanced class waiver likewise provides a streamlined waiver process whereby individual awardees and lower tier subcontractors in the Accelerated Site Technology Deployment program meeting the requirements described herein need not request individual waivers to gain the U.S. Government's domestic and foreign patent rights but may rely on this Class Waiver to obtain such rights. In the event that an individual awardee or subcontractor can not satisfy the criteria for obtaining patent rights under this class waiver, that awardee or subcontractor may request a waiver in accordance with DOE's published waiver regulation.

The philosophy underlying DOE's policy in issuing the class waiver to the Technology Demonstration Projects at Technology Development-Designated Test Bed Facilities continues as DOE moves into the next phase of Accelerated Deployment in the actual cleanup of DOE and perhaps other governmental sites. Consistent with the previous waiver, this waiver is likewise subject to the march-in and preference for U.S. industry provisions, as well as the U.S. Government license, as set out in 35 USC 202-204. This waiver of the Government's patent rights in inventions as set forth herein is also conditioned on the awardee or any lower tier subcontractor accepting the advance waiver provisions, data clauses, and the attached background patent and background data clauses. The background patent and data clauses require the awardee to license the Government for purposes of site remediation, and for commercialization purposes, in the event the awardee or lower tier subcontractors fail to commercialize the subject invention. Further, the awardee or lower tier subcontractor must agree to a U.S. Competitiveness Clause. After consultation with the Assistant General Counsel for Technology Transfer and Intellectual

Property and for good cause, the above provisions may be modified by DOE Patent Counsel. Lastly, this waiver is conditioned upon the awardee, or any lower tier subcontractor wishing to obtain the benefit of the waiver, providing at least 20% cost share in the Accelerated Site Technology Deployment work, or its subcontract, as such cost share is approved by the DOE Contracting Officer for the project.


This waiver is effective for awards made under the Accelerated Site Technology Deployment, provided the other criteria of this waiver are met. The waiver will be effectuated through certification by the DOE Patent Counsel assisting the awarding office that the conditions of this waiver have been met and by incorporation of the appropriate intellectual property provisions in the award issued. Accordingly, in conformance with the policy and philosophy of the Department set out in the previous waiver mentioned and in view of the objectives and considerations set out in DOE's waiver regulation, all of which have been considered, it is believed that this waiver, as set forth above, will best serve the interest of the United States and the general public. It is therefore recommended that the waiver be granted.


Robert Fisher
Deputy Chief Counsel
Office of Intellectual Property Law

Date: 4-10-98


Based on the foregoing Statement of Considerations, it is determined that the interest of the United States and the general public will best be served by a waiver of the patent rights of the scope described above, and therefore the waiver is granted. This waiver shall not apply to any modification that substantially alters the purpose or scope of the deployment award or reduces the cost share amount required of the awardee as stated herein.

Concurrence


Gerald G. Boyd
Acting Deputy Assistant Secretary
for Science and Technology
Office of Environmental Management

Date: 4-22-98

APPROVAL


Paul A. Gottlieb
Assistant General Counsel
for Technology Transfer
and Intellectual Property

Date: APR 22 1998

WAIVER ACTION - ABSTRACT

W(C)-98-003 (CH-0952)

REQUESTOR

EM Development
Program

CONTRACT SCOPE OF WORK

To provide a streamlined waiver
process whereby individual awardees
& lower tier subcontractors need not
request individual waivers

RATIONALE FOR DECISION

Twenty Percent Cost Sharing

DISPOSITION